

REMARKS

Claims 21 through 37 are pending in this Application. Claims 1 through 20 have been cancelled and claims 21 through 37 added. Care has been exercised to avoid the introduction of new matter. Indeed adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicants would note that new claim 25 basically corresponds to original claim 2, which the Examiner indicated contains allowable subject matter. Applicants would further note that new claim 33 basically corresponds to original claim 11, which the Examiner indicated contains allowable subject matter. In addition, the specification has been amended to address typographical oversights and grammatical issues, as requested by the Examiner. Applicants submit that the present Amendment does not generate any new matter issue.

Specification

The Examiner asserted that the title is not descriptive of the claimed invention and courteously suggested a new title. By the present Amendment, the Examiner's suggestion has been implemented.

The Examiner objected to the disclosure identifying perceived informalities and courteously suggesting remedial language. The Examiner's suggestions have been implemented, thereby overcoming the stated bases for the objection to the disclosure.

The Examiner also requested correction of possible minor errors. By the present Amendment, various typographical oversights have been addressed.

The rejections:

Initially, since claims 1 through 20 have been cancelled and new claims 21 through 37 added, Applicants will treat the imposed rejections as though applied against new claims 21 through 37. Applicants submit that the previously imposed rejections are not applicable to the now claimed inventions.

Claims 1 through 20 were rejected under the second paragraph of 35 U.S.C. §112.

In the statement of the rejection the Examiner identified various perceived antecedent basis issues. This rejection is traversed.

Initially, Applicants submit that the mere assertion of a lack of literal antecedent basis does not automatically trigger the ultimate legal conclusion of indefiniteness under the second paragraph of 35 U.S.C. §112. *Bose Corporation v. JBL, Inc.* 274 F.3d 1354, 61 USPQ2d 1216 (Fed. Cir. 2001).

At any rate, in order to expedite prosecution, new claims 21 through 37 have been presented. Care has been exercised to avoid the generation of any literal antecedent basis issues. Indeed, Applicants submit that one having ordinary skill in the art would have no difficulty understanding the scope of the claimed inventions particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993).

Applicants, therefore, submit that the imposed rejection of claims 1 through 20 under the second paragraph of 35 U.S.C. §112 is not legally viable with respect to new claims 21 through 37 and, hence, should be withdrawn.

Claims 1, 6, 8, 9 and 15 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Gilliland et al.

In the statement of the rejection the Examiner asserted that Gilliland et al. disclose an optical module corresponding to that claimed, referring to Fig. 4. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.* 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There are significant differences between the claimed optical module and that disclosed by Gilliland et al. that scotch the factual determination that Gilliland et al. disclose an optical module identically corresponding to that claimed.

Specifically, in Fig. 4 of Gilliland et al., the figure relied upon by the Examiner, a Transmission Optical Subassembly (TOSA) is disclosed. An optical package (118), such as a TO can, includes an active optical element (120) such as an LED or semiconductor laser. The active optical element is mounted to a small header (115) and a protective covering (117) mounted over the header. The protective covering includes a transparent window (119). Housing (104) includes a second end which defines an optics cavity (116). A small internal cavity (126) is included within the optics cavity (116). The small internal cavity (126) receives lens (130) therein. The optics cavity (116) is configured to receive the optical package (118) permanently mounted on an alignment substrate (122). The housing (104) is also mounted on the alignment substrate (122).

Adverting to column 1, lines 62 to 64, Gilliland et al. disclose “A TOSA generally comprises a cylindrical housing formed of molded plastic or machines from a metal such as stainless steel”. If the housing (104) is formed of molded plastic, the plastic housing cannot seal the active optical element (120). Therefore, the optical package (118) is used to seal the active optical element (120).

It should be apparent from the foregoing that Gilliland et al. neither disclose nor suggest the invention defined in independent claim 21, particularly an optical module, wherein “said mounting member, said lens holding member and said lens seal said optical semiconductor element”, as required by independent claim 1.

The above argued structural difference between the claimed optical module and that disclosed by Gilliland et al. undermines the factual determination that Gilliland et al. disclose an optical module identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 6, 8, 9 and 15 under 35 U.S.C. §102 for lack of novelty as evidenced by Gilliland et al. is not applicable to new independent claim 21 and the claims dependent thereon and, hence, should be withdrawn.

Claims 4, 7 and 16 were rejected under 35 U.S.C. §103 for obviousness predicated upon Gilliland et al.;

Claim 5 was rejected under 35 U.S.C. §103 for obviousness predicated upon Gilliland et al. in view of Matsubara et al.;

Claim 10 was rejected under 35 U.S.C. §103 for obviousness predicated upon Gilliland et al.;

Claim 17 was rejected under 35 U.S.C. §103 for obviousness predicated upon Gilliland et al.;

Claim 18 was rejected under 35 U.S.C. §103 for obviousness predicated upon Gilliland et al.

Each of the above rejections under 35 U.S.C. §103 is traversed. Moreover, none of the above rejections is applicable to any of the new claims. Applicants would stress that claims 22 through 24 depend from independent claim 21, the patentability of which has been argued *supra*. Claim 25 basically corresponds to previous claim 2, indicated allowable, with claims 26 through 32 dependent thereon. Claim 33 basically corresponds to previous claim 11, indicated allowable, with claims 34 through 37 dependent thereon.

Applicants would stress that the additional comments offered by the Examiner in imposing the rejections under 35 U.S.C. §103 do not cure the above argued deficiency of Gilliland et al. The Matsubara et al. reference applied against claim 5, replaced by claim 24, does not cure the argued deficiencies of Gilliland et al. Specifically, Matsubara et al. neither disclose nor suggest an optical module corresponding to that claimed, particularly wherein a mounting member, lens holding member and lens are provided that seal the optical semiconductor element, as in independent claim 21.

Based upon the foregoing, Applicants submit that each of the imposed rejections under 35 U.S.C. §103 is not legally viable and not applicable to any of the individually presented claims and, hence, should be withdrawn.

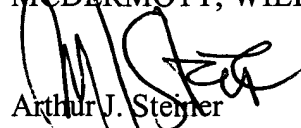
Applicants acknowledge, with appreciation, the Examiner's indication that claims 2, 3, 11 through 14, 19 and 20 contain allowable subject matter. As previously pointed out, new claim 25 corresponds to previous claim 2 in independent form, while new claim 13 basically corresponds to previous claim 11 in independent form. Accordingly, claims 25 through 37 are clearly free of the applied prior art.

Based upon the arguments submitted *supra*, Applicants submit that the objections and rejections have been overcome, and that claims 21 through 24 are also free of the applied prior art. In short, all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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